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10/724,106	12/01/2003	Robert C. Lovell JR.	2500.0017C	1422
27896 7590 02/22/2010 EDEL, SHAPIRO & FINNAN, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850				
EXAMINER				
CHAN, RICHARD				
ART UNIT		PAPER NUMBER		
2618				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

### Office Action Summary

**Application No.**

10/724,106

**Applicant(s)**

LOVELL ET AL.

**Examiner**

RICHARD CHAN

**Art Unit**

2618

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 7-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 7,013,156.

Although the conflicting claims are not identical, they are not patentably distinct from each other because each case discloses a method for routing a SMS message thru a third party in order to successfully transfer message from different carrier types.

3. Regarding claim 1, U.S. Patent No. 7,013,156 claims 1, 3, and 5 discloses the method for routing a message from a first mobile station to a second mobile station, comprising:

receiving a routing request from a third party for routing a message from the first mobile station to the second mobile station, the routing request being received by an intermediary, wherein the intermediary operates neither a physical home location register (HLR) nor a physical mobile switching center (MSC); (Col.8 line 37-47)

determining to which carrier the second mobile station subscribes, wherein an artificial IMSI value is not an IMSI value assigned to the second mobile station; dynamically creating an artificial International Mobile Subscriber Identity (IMSI) value based, at least in part, on the carrier to which the second mobile station subscribes; Claim 5, (Col.9 line 1-3)

and returning a routing response from the intermediary to the third party for routing the message from the first mobile station to the second mobile station, the routing response including the artificial IMSI value, such that the intermediary is considered, from the point of view of the third party, a mobile switching center, wherein the steps of receiving and returning employ SS7.(Claim 3, Col.8 line 61-64)

2. (Original) The method according to claim 1, wherein the mobile switching center is a virtual mobile switching center. (Claim 1, Col.8 line 44-52)

3. (Original) The method according to claim 1, wherein determining to which carrier the second mobile subscribes includes performing a lookup of the second mobile station against a database including a plurality of mobile stations associated with a plurality of

carriers so that the intermediary functions as a virtual home location register. (Claim 5, Col.9 line 1-3)

4. (Original) The method according to claim 1, wherein the second mobile station is a domestic mobile station, and the carrier to which the second mobile station subscribes and the intermediary are in geographic proximity. (Claim 1, Col.8 line 33-44)

5. (Original) The method according to claim 4, wherein the first mobile station is an international mobile station and a carrier associated with the first mobile station is on a Global System for Mobile Communication (GSM) network. (Claim 1, Col.8 line 53-55)

6. Cancelled

7. (Currently Amended) A method for routing a Global System for Mobile Communication (GSM) Mobile Application Part (MAP) Send Routing Info for Short Message (SRI for SM) message from a third party in connection with sending a message from a first mobile station on a GSM network to a second mobile station, comprising: (Claim 1, Col.8 line 53-55)

receiving a routing request from the third party for routing a message from the first mobile station to the second mobile station, the routing request being received by an intermediary via a SS7 network; (Col.8 line 37-47)

determining to which carrier the second mobile station subscribes; dynamically creating an artificial International Mobile Subscriber Identify (IMSI) value based, at least in part, on the carrier to which the second mobile station subscribes, wherein the artificial IMSI value is not an IMSI value assigned to the second mobile station; and returning a routing response from the intermediary to the third party for routing the message from the first mobile station to the second mobile station, the routing response including the artificial IMSI value, such that the intermediary is considered, from the point of view of the third party, as a mobile switching center. Claim 5, (Col.9 line 1-3)

8. (Original) The method according to claim 7, wherein the mobile switching center is a virtual mobile switching center. (Claim 1, Col.8 line 44-52)

9. (Original) The method according to claim 7, wherein determining to which carrier the second mobile subscribes includes performing a lookup of the second mobile station against a database including a plurality of mobile stations associated with a plurality of carriers, whereby the intermediary functions as a virtual home location register. (Claim 1, Col.8 line 44-52)

10. (Original) The method according to claim 7, wherein the second mobile station is a domestic mobile station and the carrier to which the second mobile station subscribes and the intermediary are in geographic proximity. (Claim 1, Col.8 line 53-55)

11. (Previously Presented) An intermediary comprising: a virtual network device configured to receive routing requests from third parties for routing a message from one mobile station to another mobile station and to return routing responses to the third parties; (Claim 1, Col.8 line 53-55)

and a gateway interface device including a database storing a plurality of mobile station identifiers associated with a plurality of carriers, the gateway interface device being configured to perform a lookup to determine to which carrier the second mobile subscribes when provided a specific mobile station identifier and to return the carrier associated with the specific mobile station identifier, the gateway interface device being configured to create an artificial International Mobile Subscriber Identity (IMSI) value based, at least in part, on the associated carrier and to provide to the virtual network device the artificial IMSI value such that the intermediary appears, from the point of view of third parties, as a mobile switching center, wherein an artificial IMSI value is not an IMSI value assigned to the another mobile station, (Col.8 line 37-47)

and wherein the virtual network device and the gateway interface device communicate such that, from the point of view of third parties, the intermediary appears to operate a HLR and a MSC. .(Claim 3, Col.8 line 61-64)

12. (Previously Presented) The intermediary according to claim 11, wherein the intermediary periodically uploads information including mobile station identifiers of carriers supported by the intermediary to the third parties. (Claim 6, Col.9 line 4-7)

13. (Previously Presented) The method of claim 1, wherein the artificial International Mobile Subscriber Identify (IMSI) value comprises a mobile country code (MCC), a mobile network code (MNC), an internal receiver ID associated with an intermediary component that processed an SRI for SM message, and an index number assigned by the intermediary. (Claim 6, Col.9 line 4-7)

14. (Previously Presented) The method of claim 7, wherein the artificial International Mobile Subscriber Identify (IMSI) value comprises a mobile country code (MCC), a mobile network code (MNC), an internal receiver ID associated with an intermediary component that processed an SRI for SM message, and an index number assigned by the intermediary. .(Claim 3, Col.8 line 61-64)

15. (Previously Presented) The intermediary of claim 11, wherein the artificial International Mobile Subscriber Identify (IMSI) value comprises a mobile country code (MCC), a mobile network code (MNC), an internal receiver ID associated with an intermediary component that processed an SRI for SM message, and an index number assigned by the intermediary. .(Claim 3, Col.8 line 61-64)

***Response to Arguments***



4. Regarding applicant's proposed amendments sent over Fax on 2/02/10 and discussed over the Examiner Initiated Interview, if such amendments were introduced during prosecution the prior art rejection as indicated will be vacated.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,3-5, 7, and 9-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over McIntosh (US 2003/0171119 A1) in view of Serbetcioglu (US 5,719,918) and Clingerman (US 7,336,941).

With respect to claim 1, McIntosh discloses the method for routing a message from a first mobile **136** station to a second mobile station **144**, comprising: receiving a routing request from a third party **100** for routing a message from the first mobile station **136** to the second mobile station **144**, the routing request being received by an intermediary **104** and **110b**; wherein the intermediary operates neither a physical home location register (HLR) which is described in detail with Fig.4 (Paragraph 0039); wherein determining to which carrier the second mobile station subscribes; and wherein the steps of receiving and returning employ SS7 **150** (Paragraph 0039), however the

McIntosh reference does not disclose wherein the intermediary process implements a non-physical mobile switching center and wherein creating an artificial International Mobile Subscriber Identity (IMSI) value based, at least in part, on the carrier to which the second mobile station subscribes; and returning a routing response from the intermediary to the third party for routing the message from the first mobile station to the second mobile station wherein, the routing response including the artificial IMSI value, such that the intermediary is considered, from the point of view of the third party, as a mobile switching center.

The Serbetciouglu reference however discloses a virtual mobile switching center 502 in Fig.5 which is used to simulate a physical switching center 302 which is then used to interface to the rest of the network disclosed in Fig.5 (Col.8 lines 52-64)

It would have been obvious to one of ordinary skill in the art to implement a virtual mobile switching center as disclosed by Serbetciouglu to replace the physical MSC as disclosed by McIntosh in order to reduce physical space and implement dynamic software to take place of static hardware implementations.

The Clingerman reference discloses the dynamic selection of an virtual international subscriber identification (IMSI) value in Fig.1. IMSI selection takes place which can be defined by a MCC and MNC. (Col.7 line 19-32)

It would have been obvious to one of ordinary skill in the art to implement a dynamic selection of the IMSI value by the carrier as disclosed by Clingerman to the method of routing a message as disclosed by McIntosh in order to identify the user mobile station and determine to which carrier the user's mobile unit belongs to.

With respect to claim 3, McIntosh, Serbetciouglu, and Clingerman combined disclose the method according to claim 1, wherein determining to which carrier the second mobile subscribes includes performing a lookup of the second mobile station against a database **128** including a plurality of mobile stations associated with a plurality of carriers so that the intermediary functions as a virtual home location register. **[0034]**

With respect to claim 4, McIntosh, Serbetciouglu, and Clingerman combined disclose the method according to claim 1, wherein the second mobile station is a domestic mobile station, and the carrier to which the second mobile station subscribes and the intermediary are in geographic proximity. **[Fig.3]**

With respect to claim 5, McIntosh, Serbetciouglu, and Clingerman combined disclose the method according to claim 4, wherein the first mobile station is an international mobile station and a carrier associated with the first mobile station is on a Global System for Mobile Communication (GSM) network. **[0035]**

With respect to claim 7, McIntosh discloses the method for routing a Global System for Mobile Communication (GSM) **[0035]** Mobile Application Part (MAP) Send Routing Info for Short Message (SRI for SM) message from a third party in connection with sending a message from a first mobile station 136 on a GSM network to a second mobile station 144, **[0038]** comprising: receiving a routing request from the third party

for routing a message from the first mobile station to the second mobile station, the routing request being received by an intermediary via a SS7 network; [0027]  
determining to which carrier the second mobile station subscribes; [0032-0035]  
however McIntosh does not specifically disclose dynamically creating an artificial International Mobile Subscriber Identify (IMSI) value based, at least in part, on the carrier to which the second mobile station subscribes; and returning a routing response from the intermediary to the third party for routing the message from the first mobile station to the second mobile station, the routing response including the artificial IMSE value, such that the intermediary is considered, from the point of view of the third party, as a mobile switching center.

The Serbetciouglu reference however discloses a virtual mobile switching center 502 in Fig.5 which is used to simulate a physical switching center 302 which is than used to interface to the rest of the next work disclosed in Fig.5 (Col.8 lines 52-64)

It would have been obvious to one of ordinary skill in the art to implement a virtual mobile switching center as disclosed by Serbetciouglu to replace the physical MSC as disclosed by McIntosh in order to reduce physical space and implement dynamic software to take place of static hardware implementations.

The Clingerman reference discloses the dynamic selection of an virtual international subscriber identification (IMSI) value in Fig.1. IMSI selection takes place which can be defined by a MCC,and MNC. (Col.7 line 19-32)

It would have been obvious to one of ordinary skill in the art to implement a dynamic selection of the IMSI value by the carrier as disclosed by Clingerman to the

method of routing a message as disclosed by McIntosh in order to identify the user mobile station and determine to which carrier the users mobile unit belongs to.

With respect to claim 9, McIntosh, Serbetcioglu, and Haumont combined disclose the method according to claim 7, wherein determining to which carrier the second mobile subscribes includes performing a lookup of the second mobile station against a database 128 including a plurality of mobile stations associated with a plurality of carriers, whereby the intermediary functions as a virtual home location register.

**[0034]**

With respect to claim 10, McIntosh, Serbetcioglu, and Haumont combined disclose the method according to claim 7, wherein the second mobile station is a domestic mobile station and the carrier to which the second mobile station subscribes and the intermediary are in geographic proximity. **[0034]**

With respect to claim 11, McIntosh discloses a virtual network device 128 Fig.4 configured to receive routing requests from third parties for routing a message from one mobile station 136 to another mobile station 144 and to return routing responses to the third parties network 100 Fig.3; an intermediary comprising: a gateway interface device including a database HLR 116 storing a plurality of mobile station identifiers associated with a plurality of carriers (Paragraph 33), the gateway interface device being configured to perform a lookup to determine to which carrier

the second mobile subscribes when provided a specific mobile station identifier and to return the carrier associated with the specific mobile station identifier,(Paragraph 0036), however McIntosh does not specifically disclose wherein the gateway interface device being configured to create an artificial international mobile subscriber identity (IMSI) value based, at least in part, on the associated carrier and to provide to the virtual network device the artificial IMSI value such that the intermediary appears, from the point of view of third parties, as a mobile switching center and wherein the virtual network device and the gateway interface device communicate such that, from the point of view of third parties, the intermediary appears to operate a HLR and a MSC.

The Clingerman reference discloses the dynamic selection of an virtual international subscriber identification (IMSI) value in Fig.1. IMSI selection takes place which can be defined by a MCC,and MNC. (Col.7 line 19-32)

It would have been obvious to one of ordinary skill in the art to implement a dynamic selection of the IMSI value by the carrier as disclosed by Clingerman to the method of routing a message as disclosed by McIntosh in order to identify the user mobile station and determine to which carrier the users mobile unit belongs to.

The Serbetciouglu reference however discloses a virtual mobile switching center 502 in Fig.5 which is used to simulate a physical switching center 302 which is than used to interface to the rest of the next work disclosed in Fig.5 (Col.8 lines 52-64) which from the view of third parties would seem to operate a HLR and a MSC.

It would have been obvious to one of ordinary skill in the art to implement a virtual mobile switching center as disclosed by Serbetcioglu to replace the physical MSC as disclosed by McIntosh in order to reduce physical space and implement dynamic software to take place of static hardware implementations.

With respect to claim 12 McIntosh, Serbetcioglu, and Clingerman combined disclose the method according to claim 11, however McIntosh continues to disclose wherein the intermediary periodically uploads information including mobile station identifiers of carriers supported by the intermediary to the third parties. [0033]

Regarding claims 13-15, McIntosh, Serbetcioglu, and Clingerman combined disclose the method according to claim 1 and 7 and 11, Clingerman continues to disclose wherein the artificial International Mobile Subscriber Identify (IMSI) value comprises a mobile country code (MCC), a mobile network code (MNC), an internal receiver ID associated with an intermediary component that processed an SRI for SM message, and an index number assigned by the intermediary. (Col.7 line 19-32)

7. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntosh (US 2003/0171119 A1) and Serbetcioglu (US 5,719,918) and Clingerman (US 7,336,941). in view of Lam (US 6,782,276).

With respect to claim 2 and 8, McIntosh, Serbetciouglu, and Clingerman combined disclose the method according to claim 1 and 7, however does not disclose wherein the mobile switching center is a virtual mobile switching center.

The Lam reference however discloses wherein a mobile switching center is a virtual mobile switching center **31** that is implemented within a SS7 protocol environment. **(Col.4 lines 12-30)**

It would have been obvious to one of ordinary skill in the art to implement the Virtual Mobile Switching Center technique as described by Lam with the method of routing a message as disclosed by McIntosh in order to effectively distribute message requests between multiple end user devices with each other.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD CHAN whose telephone number is (571)272-0570. The examiner can normally be reached on Mon-Fri 10AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571)272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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